

REMARKS

The Examiner's continued attention to the application is noted with appreciation.

Independent claims 1, 18 and 30, and dependent claim 40 have been amended.

Claim Objections

In the Office Action dated November 10, 2008, Claim Objections Section, the Examiner objected to claim 1 line 3, stating that the word "being" should be added. Claim 1 has been amended in compliance with the Examiner's request.

Claims Rejected Under 35 U.S.C. § 102

Sophie Curtis Article

The Examiner rejected claims 1 under 35 U.S.C. § 102(b) as being anticipated by an article by Sophie Curtis discussing the renovation of 38-39 Devonshire Place in Brighton, United Kingdom. Applicant respectfully disagrees. Applicant has amended claim 1 to recite the following element, "and integral sides" and "said light tube closed at said top and at said bottom." Applicant's invention is also wider at the top than at the bottom (as also recited in claim 1). None of these elements are shown in Curtis.

The Curtis device has a different shape than Applicant's invention. In fact, it is a set of glass windows with metal frames set upon the building itself, which opens into a room. It is not readily discerned from the article, however, the Curtis device actually looks like separate panes of glass forming a window rather than any type of tubular skylight, and what the Examiner labels as a "tube" are clearly the walls of the building and not integral sides.

The Examiner said [the Curtis photograph shows the skylight] "wider at said top than at said bottom". This is not true. See the photos which clearly show that the Curtis skylight is much wider at the bottom than at the top. In contrast, Applicant recites "wider at said top than at said bottom." The Curtis device is clearly a completely different device than Applicant's invention. Accordingly, we believe that claim 1 is allowable over Curtis.

O'Neill (U.S. Patent No. 6,363,667)

The Examiner rejected claims 18, 22-23, 41-42, and 46 under 35 U.S.C. § 102(e) as anticipated by O'Neill (U.S. Patent No. 6,363,667). Applicant respectfully disagrees.

Applicant's amended claim 18 discloses a tapered tube which is rectilinear along its entire length, does not require flashing and is wider at the top than at the bottom (see Fig. 1). O'Neill discloses a device that is wider at the bottom than at the top. O'Neill discloses the bottom being wider as an advantage over skylights without a wider bottom than a top width (see Figs 2B-5; and Col. 4, lines 18-21). At Col. 12-13, beginning line 64, O'Neill describes the larger lower aperture as a "key physical and geometrical feature...necessarily present..."

In addition, the O'Neill device uses flashing and does not have a sealed tube. Applicant recites a light tube sealed both at the top and the bottom. Amended claim 18 also identifies that the direct contact of the skylight with the roof is without the requirement of flashing. The Examiner states that O'Neill discloses the use of a flashing member, but that O'Neill Fig. 4B shows where the tube directly contacts the roof. This is incorrect. O'Neill discloses that weather-sealing to combat the roof penetration and flashing is not included in the discussion because it is not a part of the device (Col. 11, lines 29-47). Fig. 4B is only a drawing of the O'Neill skylight device through a roof, not a detailed schematic drawing which shows necessary components. The Examiner's interpretation of the drawing is in direct opposition to O'Neill's disclosure, "similarly, the specific means of weather sealing the roof penetration, generally including flashing and sealants are not described herein" (Col. 11, lines 37-39). One element of Applicant's invention is that the invention may be sealed to the roof, without the need for flashing, thereby creating a much better seal and weatherproofing (Applicant's specification page 2, lines 8-14).

The Examiner also states that there is an O'Neill claim that discloses direct contact of the device with the roof. This is also incorrect. Applicant did not find any such O'Neill claim which states that the tube contacts the roof directly and does not require flashing. Because O'Neill does not anticipate every element of Applicant's claim, we believe that independent claim 18 is allowable over O'Neill.

Claims 22-23, 41-42, and 46 are dependent upon independent claim 18. Accordingly, claims 22-23, 41-42, and 46 are also believed to be allowable over O'Neill.

Claims Rejected Under 35 U.S.C. § 103

The Examiner rejected claims 1,3-4, 7-8, 10-11, 16, 30-32, 37-40, 45 and 47 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article. Curtis does not cure the deficiencies of O'Neill, and in combination O'Neill and Curtis would comprise a completely distinguishable and different invention than Applicant's invention.

Applicant's amended claim 1 discloses a tapered light tube comprising a top and a bottom and integral sides, wherein the light tube is closed at the top and at the bottom. Applicant's amended claim 1 also discloses the light tube wider at the top than at the bottom. As the Examiner points out, O'Neill does not disclose the tube as wider at the top than at the bottom (O'Neill actually discloses an advantage over tubes that are not wider at the bottom); and in viewing the article by Curtis, the skylight "tube" is wider at the bottom as well. The Examiner's view that the skylight in the photograph shows a skylight tapering to a smaller width is absolutely incorrect.

Also, the Curtis device is a skylight on top of a building, where the walls open to the room. It does not have integral sides.

Additionally, O'Neill discloses the "ancillary" sealing of the skylight, and does not disclose the ability to directly contact the roof without the need for flashing.

Also, the Curtis device, as shown in the article, is really a group of panes of glass on top of an interior structural base, that opens into the room, and is not a "tubular" skylight. Therefore, we believe that independent claims 1 and 30 are allowable over O'Neill in view of Curtis.

Accordingly, it is believed that claims 3-4, 7-8, 10-11, 16, 31-32, 37-40, 45 and 47 are allowable over O'Neill in view of Curtis.

The Examiner rejected claims 5 and 21 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article further in view of Boyd (U.S. Patent No. 2,858,734).

The Examiner rejected claims 17 and 29 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article further in view of Hoy et al. (U.S. Patent No. 6,604,329).

The Examiner rejected claims 12,15 and 33 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article further in view of Lynch (U.S. Patent No. 5,596, 848).

The Examiner rejected claims 24 and 26 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Lynch (U.S. Patent No. 5,596, 848).

The Examiner rejected claims 13-14 and 34 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article further in view of Chao et al. (U.S. Patent No. 5, 896,713).

The Examiner rejected claim 25 and 27 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Chao et al. (U.S. Patent No. 5, 896,713).

The Examiner rejected claim 35 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of Sophie Curtis article further in view of Peterson (U.S. Patent No. 6,351,923).

The Examiner rejected claim 36 under 35 U.S.C. § 103(a) as unpatentable over O'Neill (U.S. Patent No. 6,363,667) in view of in view of Peterson (U.S. Patent No. 6,351,923).

Claims 5,12-15,17, 21, 24, 25-27, 29, and 33-36, and all other dependent claims are dependent on independent claims 1, 18 and 30 respectively. None of the references presented by the Examiner include all claimed elements of Applicants invention, as is required under MPEP § 2143.03. None of the references presented by the Examiner teach nor render obvious Applicant's invention, either alone or in combination. None of the references presented by the Examiner cure the deficiencies of any of the other references. Therefore, we believe that Applicant's invention as claimed is in condition for allowance.

In particular, amended claims 45-47 recite a randomly diffused dome. The Examiner incorrectly states that "the different shapes of domes, as well as colored domes, partially transparent domes, etc. ... will lead to random diffusion of the light passing through the dome (in reference to O'Neill)." Applicant's invention has deliberately included random diffusion. It is not "random diffusion" from a mish-mash of components ending up in a possibly random fashion. As shown in Fig. 2 and on Page 7, lines 25-26 of the original application, the dome is manufactured with ridges and depressions in a random pattern to maximize energy collection without the need for exact skylight placement, or an automated system. Curtis has no diffusion.

Because the Examiner's interpretation of Sophie Curtis was incorrect (stating that the skylight was wider at the top than at the bottom, rather than that it is actually wider at the bottom than the top), Applicant requests an allowance or substantive non-final action without the need to file a Request for Continued Examination. Applicant had to respond, at a substantial expense, to unnecessary rejections and combinations in light of this misinterpretation. This would be greatly appreciated.

Authorization is given to charge payment of any additional fees required, or credit any overpayment, to Deposit Acct. 13-4213.

An earnest attempt has been made to respond to each and every ground of rejection advanced by the Examiner. However, should the Examiner have any queries, suggestions or comments relating to a speedy disposition of the application, the Examiner is invited to call the undersigned. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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